

REMARKS

As reflected in the Listing of Claims, claims 1, 5-7, 13, 14, 17, 21-24, and 28-33 are pending in this application. Claims 1, 5-7, 13, 14, 17, 21-24, and 28-30 have been amended; claims 2-4, 8-12, 15, 16, 18-20, and 25-27 have been canceled, without prejudice or disclaimer; and claims 31-33 are newly added.

In the Office Action dated April 7, 2006, the Examiner objected to the specification; objected to claim 10; rejected claims 29 and 30 under 35 U.S.C. § 112, second paragraph; rejected claims 1-4, 11, 14-20, and 24-27 under 35 U.S.C. § 102(e) as being anticipated by *Sloan et al.* (U.S. Patent Publication No. 2003/0144936); rejected claims 5-7, 13, 21-23, and 28-30 under 35 U.S.C. § 103(a) as being unpatentable over *Sloan et al.* in view of the Examiner's Official Notice; and rejected claims 8-10 and 12 under 35 U.S.C. § 103(a) as being unpatentable over *Sloan et al.* in view of *Litzow et al.* (U.S. Patent Publication No. 2003/0093414).

Applicants have amended the specification to correct the typographical errors in accordance with the Examiner's suggestions. Applicants thereby respectfully request that the objection to the specification be withdrawn. Further, the cancellation of claim 10 renders the objection to that claim moot.

Further, Applicants have amended claims 29 and 30 to recite "[a] computer for providing." Accordingly, this claim is definite and not ambiguous. Applicants thereby respectfully request that the § 112 rejection of claims 29 and 30 be withdrawn.

Applicants respectfully traverse the Examiner's rejection of claims 1, 14, 17, and 24 under 35 U.S.C. § 102(e). In order to properly establish that *Sloan et al.* anticipates

Applicants' claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Amended independent claim 1, recites, *inter alia*:

analyzing the customer information using a filter that categorizes a customer into a life status, wherein the life status corresponds to the customer's demographic classification;

...

automatically revising, based on changes to the customer information, the customer's life status; and selecting, from a set of financial products, a financial product for the customer based on said revised life status using the data structure that relates each life status type to a particular financial product.

Amended independent claims 17 and 24, although of different scope, recite similar subject matter. Contrary to the Examiner's assertions, *Sloan et al.* fails to disclose at least these recitations.

Sloan et al. discloses an automated financial advising and coaching system. (See *Sloan et al.*, Abstract.) The advise dispensed by the system is in part based upon life path model data, a user's financial information, external market data, and interaction data. (*Id.* at ¶ 32.) *Sloan et al.* sets forth that the life path model data is the output data of a LifePath model, which "aggregates the user life intentions into a cash flow model

over a desired period of time.” (*Id.*) Moreover, using a terminal of the system, “a user inputs his life intentions in terms of projected income and expenses.” (*Id.* at ¶ 58.)

Applicants disagree with the Examiner’s interpretation of the LifePath model of *Sloan et al.* as the claimed “life status.” (See *Office Action*, pp. 3-4.) As set forth in the specification and claim language, a customer is designated a life status based upon “analyzing the received customer information using a filter that categorizes a customer into a life status.” Thus, the claimed “life status” of a customer is not based upon the input of a user’s “projected income and expenses,” as set forth by *Sloan et al.* (*Sloan et al.*, ¶ 58.) Instead, the claimed “life status corresponds to the customer’s demographic classification.” Moreover, the information used to classify a customer is received from various databases and not the input of the customer.

In addition, *Sloan et al.* does not disclose “automatically revising, based on a change to the customer information, the customer’s life status.” The LifePath model is based directly on a user’s input, as discussed above, and external market data, such as mortgage interest rates or market inflation rates stored in external databases. (*Id.* at ¶ 59.) These external databases do not include the claimed “customer information.”

Sloan et al. therefore does not disclose each and every element of independent claims 1, 17, and 24, and as a result, the anticipation rejection under 35 U.S.C. § 102(e) is improper. Accordingly, Applicants respectfully request the withdrawal of the rejection and the timely allowance of claims 1, 17, and 24.

Dependent claim 14 depends from independent claim 1. As explained, the cited art is distinguishable from claim 1. Accordingly, dependent claim 14 is also

distinguishable from the cited art for at least for the same reasons set forth above in connection with independent claim 1. Therefore, Applicants also respectfully request the timely allowance of dependent claim 14. Regarding claims 2-4, 8-12, 15, 16, 18-20, and 25-27, the cancellation of these claims without prejudice or disclaimer by the present amendment renders the outstanding rejections moot.

Applicants respectfully traverse the Examiner's rejection of claims 5-7, 13, 21-23, and 28-30 under 35 U.S.C. § 103(a) because the Examiner failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Furthermore, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." See M.P.E.P. § 2143.01 (8th Ed., Aug. 2001), quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Finally, there must be a reasonable expectation of success. See M.P.E.P. § 2143 (8th Ed. 2001), pp. 2100-122 to 127.

As discussed above, *Sloan et al.* does not disclose the claimed "life status" nor "automatically revising, based on changes to the customer information, the customer's life status," as recited in independent claim 1, and similarly recited in independent claims 17 and 24. The Examiner's assertion of Official Notice does not cure the deficiency of *Sloan et al.* Indeed, the Examiner has only asserted Official Notice for the

alleged disclosure of “determining the creditworthiness of the customer.” (*Office Action*, pp. 6-7.) Applicants also do not acquiesce in the Examiner’s Official Notice.

Additionally, the Examiner admits that *Sloan et al.* does not teach or suggest determining the creditworthiness of the customer. To compensate for this shortcoming, the Examiner takes Official Notice that such processes are “well known in the art” and it would have been obvious to one of ordinary skill in the art to modify *Sloan et al.* accordingly. (*Office Action*, p. 7.)

Applicants traverse the Examiner’s taking of Official Notice that the above-noted recitations of claims 5-7, 13, 21-23, and 28-30 are well known. An Official Notice rejection is improper unless the facts asserted are well-known or common knowledge in the art, and capable of instant and unquestionable demonstration as being well-known. See M.P.E.P. § 2144.03, the procedures set forth in the Memorandum by Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy dated February 21, 2002, and the precedents provided in *Dickinson v. Zurko*, 527 U.S. 150, 50 U.S.P.Q.2d 1930 (1999) and *In re Ahlert*, 424 F.2d, 1088, 1091, 165 U.S.P.Q. 418, 420 (CCPA 1970). Further, any facts asserted as well-known should serve only to “fill in the gaps” in an insubstantial manner. It is never appropriate to rely solely on “common knowledge” without evidentiary support in the record as the principal evidence upon which a rejection is based. Applicants submit that the recitations recited in claims 5-7, 13, 21-23, and 28-30 are not unquestionably well-known, and the Examiner has failed to demonstrate the contrary. Further, Applicants submit that determining the creditworthiness of the customer in the context of claims 5-7, 13, 21-23, and 28-30 is

not well known. Accordingly, Applicants traverse the Official Notice and request that the Examiner either cite a competent prior art reference in substantiation of these conclusions, or else withdraw the rejection.

Further, Applicants remind the Examiner of the following provision set forth in M.P.E.P. § 2144.03:

[w]hen a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner. Such an affidavit is subject to contradiction or explanation by the affidavits of the applicant and other persons.

To the extent the Examiner is relying on personal knowledge in taking Official Notice that the features of claims 5-7, 13, 21-23, and 28-30 are well known, Applicants request that the Examiner provide an affidavit evidencing such knowledge as factually based and legally competent to support the Examiner's conclusions. For these additional reasons, Applicants request that the rejection of claims 5-7, 13, 21-23, and 28-30 under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

Moreover, Applicants note that *Litzow et al.* also does not cure the deficiencies of *Sloan et al.* *Litzow et al.* fails to disclose at least, "analyzing the received customer information using a filter that categorizes a customer into a life status, wherein the life status corresponds to the customer's demographic classification," as recited in amended claims 1, 17, and 24.

Furthermore, Applicants call attention to M.P.E.P. § 2143.01, which makes clear that a "prior art reference must be considered in its entirety, i.e., as a whole, including

portions that would lead away from the claimed invention.” Certainly, as noted in M.P.E.P. § 2143.01, “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” Accordingly, the Examiner has not shown why a skilled artisan would have altered *Sloan et al.*, which is not concerned with utilizing data stored within relational databases for dynamic price setting and the facilitation of commercial transactions, as set forth in *Litzow et al.* Indeed, *Sloan et al.* teaches a method and system for providing an individual with automated financial advice and coaching. Therefore, modifying *Sloan et al.* to receive customer information from at least one source chosen from a purchase database, an application database, a call center database, an Internet database, and a public records database as recited in amended claim 1 would change the principle of operation of the prior art invention being modified. Finally, the Examiner has not established that there would be a reasonable expectation of success in modifying *Sloan et al.* as alleged. For at least these additional reasons, no *prima facie* case of obviousness has been established and amended claims 1, 5-7, 13, 14, 17, 21-24, and 28-30 are allowable over the cited art.

Regarding newly added claims 31-33, these claims depend from independent claims 1, 17, and 24, respectively. Accordingly, claims 31-33 are also distinguishable from the cited art for at least for the same reasons set forth above in connection with independent claims 1, 17, and 24. Therefore, Applicants also respectfully request the timely allowance of dependent claims 31-33.

The preceding arguments are based on the arguments presented in the Office Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the Office Action. The pending claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding argument in favor of patentability is advanced without prejudice to other bases of patentability. Furthermore, the Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: August 7, 2006

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